

RECEIVED

JAN 30 2004

OFFICE OF PETITIONS

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q62798

Taku ISHIZAWA, et al.

Appln. No.: 09/765,411

Group Art Unit: 2861

Confirmation No.: 9456

Examiner: Anh Vo

Filed: January 22, 2001

For: INK CARTRIDGE, AND INK-JET RECORDING APPARATUS USING THE SAME

**PETITION TO WITHDRAW FINALITY
UNDER 37 C.F.R. § 1.181**

ATTN: Technology Director
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
FEB - 2 2004
TECHNOLOGY CENTER 2800

Sir:

This is a petition to withdraw the finality of the Office Action dated December 9, 2003. This petition is being filed prior to two months after the action complained of, and therefore, is timely (37 C.F.R. § 1.181((f)).

Applicants respectfully submit that the December 9 Action has improperly been made "final," and respectfully solicits withdrawal of the "finality."

MPEP § 706.07(a) indicates that a "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an

information disclosure statement filed during the period set forth in 37 CFR 1.97(c) ...”
(emphasis added).

In the December 9 Action, the Examiner has introduced new grounds of rejection against independent claim 47 and dependent claim 48. Specifically, claims 47 and 48 now stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sato* (JP 60-198256A) in view of *Wax* (US 4,119,034).¹

These new rejections were not necessitated by applicant’s amendment, as claims 47 and 48 were not amended in response to the April 28, 2003 Office Action.

Further, these new rejections were not based upon information submitted in an information disclosure statement (IDS) during the 37 C.F.R. § 1.97(c) period, as *Wax* (US 4,119,034) was first cited by the Examiner in the December 9, 2003 Final Office Action.

Thus, for *at least* the above reasons, Applicants respectfully submit that the December 9 Action is an improper “final” Office Action, and requests the corresponding withdrawal of the “finality.”

Additionally, as the December 9, 2003 Office Action should be a “Non-Final” Office Action, Applicants respectfully submit that the IDS submitted herewith should be entered, and the reference cited therein immediately considered by the Examiner.


¹ Claims 47 and 48 were rejected under 35 U.S.C. § 102(a) as being anticipated by *Sato* in the previous Office Action (dated April 28, 2003).

Petition To Withdraw Finality Under 37 C.F.R. § 1.181
U.S. Appln. No.: 09/765,411

Attorney Docket # Q62798

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,



Timothy P. Cremen
Registration No. 50,855

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: January 23, 2004